REMARKS

In response to the final Office Action mailed 22 October 2003 and the Advisory Action mailed 18 February 2004, the application has been carefully reviewed and amended. Applicant thanks Examiner Uhlir for his analysis of the cited references and detailed Office Actions, contributing to advancing prosecution of the application. Applicant respectfully requests entry of the present amendment and reconsideration of the application.

Rejections under 35 U.S.C. §103

Claims 5-20, 23-24, 26, 33-39, 42-43, 56, 58-61, and 63-65

Claims 5-20, 23-24, 26, 33-39, 42-43, 56, 58-61, and 63-65 stand rejected under 35 U.S.C. §103 as being obvious over Junker (U.S. Patent No. 4,994,311) in view of Ford (U.S. Patent No. 5,545,448). [Paper 18, Page 2, Paragraph 3]

Structure of the fused/colliquefied coating

Each of the independent claims, Claims 1, 5, 10, 20, 35, 40, 42, 44, 50, 56 and 61 have been amended to generally recite a specific structure of the resulting colliquefied/fused powder coating.

Specifically, the claims recite "a contiguous surface film on the portion of the metal reinforcing member and the portion of the resilient polymeric body" (Claim 1); "a continuous coating on the first portion and the second portion" (Claim 5); "a contiguous surface on the first portion and the second portion" (Claim 10); "a fused contiguous surface film on the portion of the base and the portion of the resilient sealing portion" (Claim 20); "a contiguous fused film on the first portion and the second portion" (Claim 35); "a contiguous colliquefied surface film on the reinforcing member and the portion of the polymeric body" (Claim 40); "a contiguous surface film on the first portion and the second portion of the weatherseal body" (Claim 42); "a contiguous layer on the surface of the sealing portion and the carrier portion" (Claim 44); "a contiguous colliquefied layer on the portion of the sealing portion and the trim portion" (Claim 50); "a contiguous fused layer on the sealing portion and the carrier portion" (Claim 56); and "a continuous

colliquefied surface layer on the portion of the sealing portion and the trim portion" (Claim 61).

As set forth in Junker,

> **The sintering process is such as to produce very small "dots" of the sintered material on the low friction areas. The contact made with the sliding glass is therefore point-contact, rather than area-contact, and this reduces the friction. Because the sintering process produces these "dots" of material, dirt which may be present can pass through the pattern of dots and is not smeared over the glass (provided that the dirt grains are below a certain size).**
>
> (Col. 3, line 38-Col. 4, line 5)

Therefore, applicant respectfully submits the present claims clearly distinguish over the art of record. As recognized by the Examiner, the primary reference Junker is designed to form "islands".

The secondary reference Ford suggests the application of the surface coloring can only be achieved by the recited solution chemistry.

Applicant respectfully submits Ford suggests the specific chemistry set forth in Ford is required to achieve a necessary bonding of the colored spray coating. Specifically,

> Traditionally, in the motor industry, coloured plastics edge trims or U-shaped flange gripping strips in which a carrier may be located, are often combined with elastomeric dynamic sealing bulbs or lips which are normally black, the elastomeric material providing the correct degree of elasticity, as this cannot be achieved ,with extruded plastics materials.
>
> (Col. 1)

Thus, Ford suggests extruded plastics materials cannot be employed. Further, Ford states:

> In the motor industry, there is now considerable reluctance to use plastics materials, such as PVC which can be extruded in almost any chosen colour, for door seals and the like because they are toxic and could be dangerous in a fire. (Col. 1)

The use of colored plastics materials is expressly discouraged by Ford. In addition, Ford recites:

> and/or to the external paintwork of the vehicle. It is, however, recognised that it is not easy to paint or otherwise to colour black elastomeric material in a cost-effective manner. (Col. 1, lines 38-40)

Thus, painting the elastomeric material is excluded by Ford. Applicant respectfully submits Ford then does suggest that the recited goal of the colored coating on both the trim and a seal portion can be achieved *only* by specific chemistry. Ford expressly states the chemistry is provided in "an exact proportion" to allow for the "precise reaction".

> The above component is then blended in an exact proportion to allow precise reaction stoichiometry with the cross linking component, this being a solution of two aliphatic polyisocyanates in aromatic hydrocarbon and aliphatic ester solvents in which fluorocarbon polymer is suspended. (Col. 3)

Ford then further recites the exact and precise chemistry as "critical" to achieve the necessary adhesion flexibility in the light fastness.

> The ratio of the individual polyisocyanates to each other is critical in affording a polyurethane coating material with the correct properties of adhesion, flexibility and light fastness. (Col. 3, lines 26-29)

As Junker only discloses (i) the formation of dots, rather than a continuous surface film (ii) over only a single material (the gripping portion) of the weatherseal, and

Ford teaches critical chemistry for precise reactions in order to achieve the desired result, applicant respectfully submits the proposed combination of references cannot sustain a rejection under 35 U.S.C. § 103 of the amended claims.

Applicant respectfully submits these teachings of the cited references do not suggest the asserted combination. Further, any such combination does not provide a reasonable expectation of success, as the primary reference does not form a continuous surface, and the secondary reference requires a precise chemistry.

"Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" *In re Lee*, 1434-1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). "Common knowledge and common sense, even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority." *In re Lee*, 1435. "The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale in which it relies." *In re Lee*, 1435. Therefore, the rejection of Claim 19 is legally insufficient.

In view of these deficiencies, applicant respectfully submits Claims 5-20, 23-24, 26, 33-39, 42-43, 56, 58-61, and 63-65 are in condition for allowance.

Claims 1-4, 40-41, 44, 46-50, and 52-55

Claims 1-4, 40-41, 44, 46-50, and 52-55 stand rejected under 35 USC §103 as being unpatentable over Katoh (US 4,291,076) in further view of Junker and Ford.

With respect to the rejections, the Examiner asserts Katoh teaches an automotive weatherseal comprising a metal sheet 2; a body 1; and layers 3a3, 3b3, lips 3c3 (Figure 4B and column 3, lines 50-65). [Paper 18, Page 10, Paragraph 39]. The metal layer 2 is considered by the Examiner to be equivalent to the claimed metal reinforcing layer. The body 1; layers 3a3, 3b3; and lips 3c3 are made of polymer materials and are considered by the Examiner to be equivalent to applicant's claimed resilient polymeric body. [Paper 18, Paragraph 39]

The Examiner recognizes Katoh fails to disclose a heat fusible powder coating directly on the surface of the metal reinforcing member and directly on a portion of the resilient polymeric body. [Paper 18, Paragraph 40]

The Examiner asserts it would have been obvious to coat the entire weatherseal taught by Katoh including the body 1; metal 2; coatings 1a3, 1b3, 1c3, 3a3, 3b3; and lips 3c3.

Applicant submits Katoh teaches the formation of a trim molding having an exposed metal foil.

Katoh is directed to a trim molding strip for a vehicle with an exposed metal foil. An exposed portion of the trim molding strip, as shown in Figures 2A, 2B, 3A, 3B, 4A, 4B, 4C, 5A, 5B, 6A, 6B and 6C all include an exposed metal foil.

The Examiner notes in Katoh that "Nothing is said as to the impermissibility of coating the exposed metal layer, or that doing so will frustrate the goals of the reference." [Advisory Action] Applicant submits the reference must teach the asserted combination to sustain the rejection. If the reference does not teach the combination, then the rejection cannot be sustained. It is not required that the reference render the combination "impermissible". Applicant submits even if a reference is silent, such reference is insufficient to sustain the rejection. The reference must teach the asserted combination.

Katoh teaches an exposed metal foil in a trim molding. Covering such foil would render the metal foil useless. Specifically, as set forth in Katoh, the invention is directed to a metal foil covering a synthetic resin body.

> 1. Field of the Invention
> This invention is related to trim molding strips for vehicles and, in particular, to trim molding strips for vehicles which include a synthetic resin body, a metal foil covering the body and a protective layer which covers the metal foil on the end portions of the body. (Col. 1)

In fact, each of the claims of Katoh recites in part "a metal foil bonded to said body member, said metal foil covering the center portion of said body member".

That is, were Katoh to be modified to cover the metal foil, the metal foil would serve no purpose in Katoh.

The Examiner relies upon Junker and Ford to cure the failure of Katoh to teach a heat fusible powder coating directly on the surface of a metal reinforcing member and directly on a portion of the resilient polymeric body. The Examiner relies upon the secondary references to assert it would be obvious to utilize the powder coating taught by Junker to coat the entire weatherseal taught by Katoh including the body 1, the metal 2, and the coatings. The motivation to coat the entire weatherseal of Katoh in light of the teaching of Ford is that both the gripping and sealing portions of the weatherseal are preferably coated with the color coating to match the trim of the vehicle. [Paper 18]

This is contrary to the purpose of Katoh. Katoh is directed to a trim molding strip having a synthetic resin body and an exposed metal foil. The purpose of Katoh is to provide an exposed metal surface. This is the claimed structure of Katoh.

To cover the Katoh metal would preclude it from its intended purpose, and this cannot sustain a rejection under 35 USC §103.

As the proposed modifications are expressly contrary to the cited references and would preclude the primary reference from achieving its intended purpose, the asserted rejections of Claims 1-4, 40-41, 44, 46-50, and 52-55 cannot be sustained.

Therefore, applicant respectfully submits all the pending claims, Claims 1-20, 23, 24, 26, 33-44, 46-50, 52-56, 58-61, and 63-65, are in condition for allowance and such action is earnestly solicited. If, however, the Examiner feels any further issues remain, he

is cordially invited to contact the undersigned so that such matters can be promptly resolved.

Respectfully submitted,

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